



ITM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

: Confirmation No. 6971

Karl RODEMER et al.

: Docket No. 2004-0480

Serial No. 10/808,439

: Group Art Unit 3682

Filed March 25, 2004

: Examiner Julie K. Smith

LUBRICATION DEVICE

: THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In view of the following remarks, reconsideration of the rejections contained in the Office Action of December 15, 2004 is respectfully requested.

Although the Examiner indicated in the outstanding Office Action that claims 1-23 are presently pending in this application, claims 1-22 were originally filed and are currently pending. The Examiner rejected all of the pending claims under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,742,625 (the '625 Patent). The Applicants note that this rejection is similar to the rejection set forth in the Office Action of July 28, 2004 in related divisional application 10/808,415. For the reasons set forth below (which are identical to the reasons set forth in the Request for Reconsideration filed in the related divisional application on January 28, 2005), the Applicants respectfully submit that the double patenting rejection is improper and should be withdrawn.

As indicated on page 1 of the specification of this application, the present application is a divisional application based on parent application 09/950,080 ("the parent application"), which issued as the '625 Patent on June 1, 2004. A species restriction requirement was set forth in the parent application on March 12, 2003, in which the Examiner indicated that the parent application

contains three patentably distinct species. Specifically, the Examiner enumerated Species I, directed to the species shown in Figures 1-2; Species II, directed to the species shown in Figures 3A-3D; and Species III, directed to the species shown in Figure 4. In response to the Examiner's Restriction Requirement, the Applicants elected Species I on June 10, 2003, and indicated that claims 1-9 and 11-15 read on the elected species.

Subsequently, the present divisional application was filed on March 25, 2004, in order to present claims directed to the non-elected species enumerated in the Examiner's Restriction Requirement of March 12, 2003. In particular, independent claim 1 (the only independent claim) of the present application corresponds to original non-elected independent claim 16 of the parent application, and recites subject matter that reads on non-elected Species III of the Examiner's Restriction Requirement in the parent application, shown in Figure 4 of the parent application and the present application.

The appropriate section of the U.S. code related to patents and which provides a basis for divisional applications, 35 USC § 121, explains that:

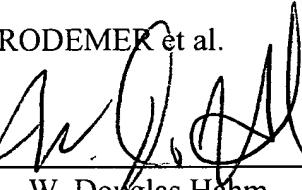
“a patent issuing on an application with respect to which a requirement for restriction under this section has been made . . . *shall not be used as a reference* either in the Patent and Trademark Office or in the courts *against a divisional application* . . . if the divisional application is filed before the issuance of the patent on the other application” (emphasis added).

As explained above, the present divisional application was filed in view of the Restriction Requirement set forth in the parent application, and was filed before the parent application issued as the '625 Patent. In other words, the present divisional application was filed in order to pursue subject matter withdrawn from consideration in the parent application in view of the Examiner's Restriction Requirement of March 12, 2003. Therefore, in view of the above-quoted portion of 35 USC § 121, it is submitted that the Examiner's double patenting rejection set forth in the outstanding Office Action is improper. Accordingly, the Examiner is respectfully requested to withdraw the double patenting rejection.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

Karl RODEMER et al.

By: 

W. Douglas Hahm
Registration No. 44,142
Attorney for Applicants

WDH/gtg
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
March 14, 2005